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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,886	11/16/2001	Kazuki Matsui	121.1027	7581
21171 7590 08/25/2010 STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER SORKOWITZ, DANIEL M	
			ART UNIT 3622	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/987,886

Applicant(s)

MATSUI ET AL.

Examiner

DANIEL SORKOWITZ

Art Unit

1

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 19-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-14 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/ISA/C3)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

Notice to Applicant

The following is a final office action on the merits for application 09/987886 in response to papers filed 8/9/2010. Claim 15 has been cancelled by Applicant. Claims 13-14 and 16-18 have been examined.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 13-14 and 16-18 are rejected under 35 U.S.C. 103 (a) as being unpatentable over US Patent Number 5,794,210 to Goldhaber et al. in view of over US Patent Number 5,657049 to Ludolph et al.**

Regarding claim 13, Goldhaber discloses an advertisement provider unit executed by the processor and displaying, on user terminals, a symbolic

image corresponding to the advertisement distributor (figure 11 and figure 13 #304-310, column 18 lines 34-54);

a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-5, an example given by the cybergold coin on a desktop);

a detector executed by the processor and for detecting that a user has selected at least one symbolic image corresponding to an information provider by clicking the symbolic image to the advertisement requesting domain; (figure 11 and figure 13 #304-310, column 18 lines 34-54, an example given by the cybergold coin on a desktop);

an advertisement distribution reservation requesting unit executed by the processor and identifying the symbolic image detected with the detector and generating and transmitting distribution reservation requesting data to the advertisement distributor corresponding to the symbolic image (column 9 line 53- 67 and column 10 lines 38-59); and

an information display unit executed by the processor and displaying advertisement information distributed from the advertisement distributor to the user terminal corresponding to the user (column 9 lines 53-67 and column 10 lines 38-59). Goldhaber does not disclose changing and managing the display position of an image in response to a user

manipulation by moving dragging and dropping or the position representing user interest. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation by clicking moving dragging and dropping (figure 9c and figure 10b #220, column 5 line 50- column 6 line 33, column 22 lines 50-65, and column 9 line 53- 67). Ludolph further discloses identifying, detecting and transmitting a symbolic image and a position of the symbolic image in the user's display domain, the position representing user interest and being one of near, middle and far (figures 5A,B and 6, column 12 line 5- column 13 line 25, desk drawer, on top is most interesting, is near, desktop display space, in background is middle, and trash is low user interest). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation of position including clicking, dragging, and dropping, with the icon selection method of Goldhaber. The position of icons, and moving, clicking, dragging, and dropping icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

Regarding claim 14, Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-54, an example given by the cybergold coin on a desktop). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50- column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber, so an advertisement provider display includes a position changing unit changing a display position of a symbolic image in response to a user manipulation and a management unit managing the display position of the symbolic image for each user, the advertisement distribution reservation requesting unit transmits the distribution reservation requesting data to the advertisement distributor, including the display position of the symbolic image as a selection object, and the

information display receives and displays the advertisement information adjusted depending on the display position of the symbolic image transmitted from the advertisement distributor. Moving icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

Regarding claims 16, Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-54, an example given by the cybergold coin on a desktop). Goldhaber does not disclose detecting whether other symbolic images already exist in the advertisement requesting domain and also transmits, when the other symbolic images are detected, information relating to the other symbolic images to the advertisement distributor. However, Ludolph discloses detecting, and changing display size of images in a common area based on action to the window as a whole(column 18 lines 25-65). Therefore, it

would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of group icon manipulation with the icon selection method of Goldhaber. Selecting all the items in a folder for a common operation is faster than having to select each item separately. Further, Concerning the step of " requesting unit detects whether other symbolic images already exist "; that limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claim 17, Goldhaber discloses an advertiser displaying its image to the users (figure 11 column 18 lines 34-55); displaying, on the user terminals, an icon for requesting an advertisement (figure 11 and figure 13 #304-310, column 18 lines 34-55, an advertisement requesting domain for accepting an advertisement distribution reservation referred to as an icon for requesting an advertisement); detecting that a user has selected or manipulated an icon to select an ad generating and transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement and other images (column 9 line 53- 67 and column 10 lines 38-59).

Regarding claim 18, Goldhaber discloses transmitting ad request data to the advertiser corresponding to the relevant symbolic image; and displaying the advertisement (column 9 line 53- 67 and column 10 lines 38-59). Goldhaber further discloses a display displaying, on the user terminals, an advertisement requesting domain including a section of a user interface for accepting an advertisement distribution reservation (figure 11 and figure 13 #304-310, column 18 lines 34-54, an example given by the cybergold coin on a desktop). Goldhaber does not disclose changing and managing the display position of an image in response to a user manipulation. However, Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation (figure 9c and figure 10b #220, column 5 line 50- column 6 line 33 and column 22 lines 50-65). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to combine Ludolph's method of icon manipulation with the icon selection method of Goldhaber so a determining unit determining whether an icon in which a manipulation is performed corresponds to the symbolic image included in the advertisement information and acquires, positional information relating to the symbolic image as the object of the advertisement information existing in the advertisement requesting domain and also transmits the symbolic image included in the advertisement

information and the obtained positional information to the advertisement distribution reservation requesting unit and the advertisement distribution reservation requesting unit also includes a generating unit generating the distribution reservation requesting data based on the symbolic image included in the advertisement information transmitted with the detector and the obtained positional information. Moving icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g. dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key.

Response to Remarks/Arguments

This rejection has been amended to reflect the changes to the claim language and addresses any arguments submitted by the applicant. Therefore, the Examiner maintains the rejection to the Applicant's claims.

Applicant argues regarding claim 13 that "Goldhaber and Ludolph, taken alone and in combination, do not discuss "detecting that a user has selected at least one symbolic image corresponding to an information provider and has moved the symbolic image by clicking, dragging and dropping the symbolic image to the advertisement requesting domain".

The Examiner disagrees. The previously cited sections of Goldhaber in combination with Ludolph are believed to render this element obvious to one skilled in the art at the time of the invention. Goldhaber discloses detecting that a user has selected at least one symbolic image corresponding to an information provider by clicking the symbolic image to the advertisement requesting domain. The cited section gives an example given by the cybergold coin on a desktop, which causes the clicking of a user to request and then receive advertisements, the desktop and computer icons are in the advertisement requesting domain. The cited section of Ludolph discloses detecting, saving, changing, and managing the display position of an image in response to a user manipulation by clicking moving dragging and dropping. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 (A) rejection still stands.

Applicant further argues regarding claim 13 that "the Office Action has paraphrased the features of claim 13 and did not address "the advertisement requesting domain." The Examiner disagrees. Goldhaber discloses detecting that a user has selected at least one symbolic image corresponding to an information provider by clicking the symbolic image to the advertisement requesting domain. The cited section gives an example given by the cybergold coin on a desktop, which causes the clicking of a

user to request and then receive advertisements. Broadly and reasonably interpreted by the Examiner to be the computer representation of the desktop and computer icons, which are clicked on by the user, as the advertisement requesting domain. Therefore, the Examiner respectfully finds the Applicant's argument unpersuasive.

Applicant further argues regarding claim 13 that "the Office Action failed to formally refer to Official Notice or well known evidence in its rejection and merely stated "[m]oving, clicking, dragging, and dropping icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g., dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key." The Examiner disagrees. The Examiner did not take Official Notice in rejecting claim 13. The previously cited sections of Goldhaber in combination with Ludolph are believed to render every element in the claim obvious to one skilled in the art at the time of the invention. The Quotation from the office action argued by the Applicant: "[m]oving, clicking, dragging, and dropping icons to perform tasks such as selecting has been used since before 1984 by the Apple Macintosh Computer to increase ease of use and fun and enjoyment by the user, e.g., dragging a file to the trash can is easier, more intuitive, and more fun than hitting the delete key", was not taking

Official Notice. This statement was given by the Examiner as an example of why one of ordinary skill in the art would be motivated to combine the two references. No Official Notice was used or taken by the Examiner. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 (A) rejection still stands.

Applicant argues regarding claim 14 that "the Office Action continues to not consider the feature: "the information display receives and displays the advertisement information adjusted depending on the display position of the symbolic image transmitted from the advertisement distributor". The Examiner disagrees. The examiner considered every element of the claim, and still believes the previously cited sections of Goldhaber in combination with Ludolph are believed to render this element obvious to one skilled in the art at the time of the invention. . Goldhaber discloses detecting that a user has selected at least one symbolic image corresponding to an information provider by clicking the symbolic image to the advertisement requesting domain. The cited section gives an example given by the cybergold coin on a desktop, which causes the clicking of a user to request and then receive advertisements, the desktop and computer icons are in the advertisement requesting domain. The cited section of Ludolph discloses detecting, saving, changing, and managing

the display position of an image in response to a user manipulation by clicking moving dragging and dropping. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 (A) rejection still stands.

Applicant further argues regarding claim 14 that "Goldhaber and Ludolph, taken alone and in combination, do not discuss displaying advertisement information adjusted depending upon the display position of the symbolic image transmitted from the advertisement distributor. Goldhaber says nothing about displaying advertisement information adjusted depending upon the display position". The Examiner disagrees. The cited section of Goldhaber teaches displaying advertisement information adjusted depending on the user clicking on the cybercoin icon. The cited section of Ludolph teaches information adjusted depending on its display position. Therefore, Examiner believes the combined references are still a reasonable teaching of the claimed invention in this regard, and the 103 rejection still stands.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANIEL SORKOWITZ** whose telephone number is (571)270-5206. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 571.272.6724.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)? If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D M S/
Examiner, Art Unit 3622

/Michael Bekerman/
Primary Examiner, Art Unit 3622